

Appl. No. 10/614,394
Amdt. Dated 9/6/2005
Response to Office action dated 3/24/2005

REMARKS

Claims 1-33 are pending. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Claim Rejections – Double Patenting

The Examiner rejected claims 1-33 as conflicting with claims 1-27 of Application No. 10/840,889 ("the child application"). The Examiner required cancellation of the conflicting claims from all but one application or the maintenance of a clear line of demarcation between the applications,

The Examiner provisionally rejections claims 1-33 under 35 USC § 101 as claiming the same invention as that of claims 1-27 of the child application.

The Examiner made identical rejections in the child application in an Office action mailed 6-17-2005.

The Examiner is requested to hold these rejections in abeyance pending a response to the Office action in the child application.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 1-6, 9-19, 22-30 and 33 under 35 USC § 102(e) as anticipated by Giordano, III (USP 6,870,828 B1). This rejection is respectfully traversed.

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Giordano is directed to a method and apparatus for automatically dialing telephone numbers which appear on a web page. In Giordano, telephone numbers in a web page are automatically recognized and displayed as icons. Giordano's preferred embodiment is a special telephone which is "Internet-capable". That is, Giordano's telephone is an analog PSTN telephone which can also receive and display Web pages from the Internet.

Giordano discloses that this specialized telephone can be used to initiate voice phone calls by clicking on the iconized phone numbers:

To call a phone number, the user selects the icon by clicking on it, or by another suitable selection method (300). The Internet-capable phone makes the determination of how to initiate the call (305). If the user has a two-line phone, the Internet-capable telephone initiates a telephone call to the selected number (335).

If the user has a one-line phone (315), the Internet-capable telephone first determines whether the line is available for a call. If the line is not currently being used for another telephone call or to connect to the Internet (325), the Internet-capable telephone initiates a voice call to the selected number (335). However, if the user is connected to the Web (320), the Internet-capable telephone automatically, and transparently, disconnects from the Internet session (330) and initiates a voice call to the selected telephone number.¹

As can be seen, Giordano's specialized telephone uses the iconified telephone number to initiate a voice phone call in the normal manner -- by dialing the other party's telephone number and connecting directly to the other party. This kind of connection is well known in the art as a single-leg call.

Because of Giordano's reliance on a special telephone, it's not surprising that such a product never found any market acceptance. In contrast, the present invention is compatible with conventional PCs and telephones.

¹ Giordano, column 4, lines 21-37.

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The invention of claim 1 is a "method of displaying telephone numbers" which is similar to Giordano. However, claim 1 operates differently. Claim 1 recites, "packaging an object corresponding to the identified telephone number, wherein the object is defined such that the telephone number is activatable" and "the object defines a function for sending a data trigger to a switch to initiate a telephone call". The specification explains, "For example, just prior to display of a web page, HTML tags and JavaScript may be added so that the telephone numbers will be displayed by the browser and provided with appropriate functionality (e.g. click-to-call)."

It can be seen that Giordano is different from the invention of claim 1. In Giordano, a special telephone initiates calls in the conventional fashion. In claim 1, objects are packaged that define a function for sending a data trigger to a switch to initiate a telephone call. The approach of claim 1 is not direct as in Giordano. Indeed, Giordano teaches away from the present invention. Whereas the claimed "object" can be formed from HTML tags and JavaScript, Giordano states that "HTML cannot be used to dial a telephone number over the Internet."² Thus, while in Giordano only a specialized telephone can initiate a call, the invention of claim 1 can be used to initiate a telephone call from nearly any device, but not necessarily having a voice call with the device. Accordingly, Giordano does not disclose, teach or suggest the method of claim 1.

The other independent claims are similarly patentable over Giordano. Independent claim 12 is directed to a "client computer" having circuits and software for performing certain steps and/or functions. Claim 23 is directed to a "computer program product" having code for performing certain steps and/or functions. Claims 12 and 23 recite the same limitations regarding the "object" as claim 1, and are therefore patentable over Giordano for the same reason.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 7, 8, 20, 21, 31 and 32 under 35 USC § 103(a) as obvious from Giordano in view of Yach et al (US Publication No. 2002/0128,036). This rejection is respectfully

² Giordano, column 1, lines 51-52.

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traversed. These claims are dependent upon claims 1, 12 or 23, and are non-obvious over Giordano in view of Yach for at least the same reasons set forth with respect to the independent claims.


Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



Steven C. Sereboff, Reg. No. 37,035

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SoCal IP Law Group
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com